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**REMARKS**

Claims 1-5, 7-9, 11-30 are currently rejected in this application. Claims 1, 5, 10, and 20 have been amended, and Claims 3, 4, and 6 have been cancelled. No new matter has been added.

Applicants respectfully request reconsideration in view of the above amendments and the following remarks.

**Applicants' Response to Double Patenting Rejection**

Claims 1, 3, 4, 5, 7, and 8 are rejected under the statutory obviousness-type double patenting with respect to Applicants' prior U.S. Patent No. 7,113,512.

In response to the obviousness-type double patenting, Applicant does not agree with that the current claims fall under the definition of double patenting. For double patenting, 35 U.S.C. § 101 prevents two patents from issuing on the same invention, where the same invention means identical subject matter. Miller v. Eagle Mfg. Co., 151 U.S. 186 (1984). The claims in the current application are not identical subject matter because the current application provides a separate embodiment of the invention claimed in U.S. Patent No. 7,113,512. More specifically, Applicants assert that the current invention narrows the scope of the invention claimed in U.S. Patent No. 7,113,512 to provide a failure notification message.

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In the interest of expediting the prosecution of this application towards allowance, Claim 1 has been amended and Claims 3-4 have been cancelled herewithin to overcome the rejection. Applicants respectfully submit that Claims 5, 7, and 8, which ultimately depend from claim 1, are patentable over the art of record by virtue of their dependency from Claim 1. Applicants further submit that Claims 5, 7, and 8 define patentable subject matter in their own right; therefore, it is respectfully requested that the rejection under obviousness-type double patenting of Claims 5, 7, and 8 be reconsidered and withdrawn.

#### Allowable Subject Matter

Applicants note with appreciation that at page 23 of the Office Action, Claims 6 and 10 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Accordingly, while not acceding to the proprietary of any claim rejections over prior art set forth in the Office Action, Applicants have rewritten Claims 1 and 10 so as to expedite the prosecution of this application towards allowance.

Specifically, independent Claim 1 has been rewritten to incorporate the subject matter of defendant Claim 6, including all of the limitations of intervening Claims 3 and 4, and Claims 3, 4, and 6 have been cancelled. Similarly, defendant Claim 10 has been rewritten in independent

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form to include all the limitations of the original Claim 1 and Claims 7, 8, and 9. Accordingly, Claims 1 and 10 are in condition for allowance.

**Applicants' Response to 35 U.S.C. § 103 Rejection**

In the Office Action, Claims 1, 2, 11-21, 26-30 were rejected under 35 U.S.C. § 103(a), as being unpatentable over EP 1320819 to Puppa et al. (Puppa) in view of U.S. Patent No. 6,947,739 to Yokoyama (Yokoyama).

Applicants have amended Claim 1 to incorporate the subject matter of allowable defendant Claim 6, including all of the limitations of intervening Claims 3 and 4. Applicants believe this amendment obviates the rejection of Claims 2 and 11-19; and therefore, reconsideration is respectfully requested.

With regards to Claim 20, Puppa is cited for teaching the features recited in Claim 20. However, it is admitted in the Office Action on page 11 that Puppa does not teach “mapping of the first destination address to a second destination address specifying in the second format the address of the destination in the second network so that the second network, upon receipt of the second destination address, can route the second frame to the destination.” Rather, col. 4, lines 1-67 of Yokoyama is cited for teaching this feature. The cited section of Yokoyama teaches mapping of the first address to the second address.

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Neither Puppa or Yokoyama, alone or in combination, teach or suggest a Remote Defect Indication, which sends a message back to a transmitting terminal that a failure has been indicated. Claim 20 of the invention recites “A network system for notifying/communicating at least one failure message from at least one source to at least one destination, said system comprising: a first network associated with the source, generates a first frame, said first frame includes a failure notification message and a first destination address in a first format compatible with the first network.” More specifically, the present invention consists of an Interworking Switch that “sends an EOAM.RDI message . . . back towards the Ethernet router 10a notifying the router 10a of the link failure  $l_1$  detection” and “converts the EOAM.AIS message . . . into an ATM.AIS message . . .” (Patent Application, Para. [0029]). Rather, Puppa teaches communicating a failure message in a forward direction from a first network to a second network, and Yokoyama teaches mapping the first address to the second address.

Applicants respectfully note that in order to support a claim of *prima facie* obviousness, the cited references must teach or suggest each and every element of the invention, and there must be a basis for combining the reference and the prior art as suggested. However, at no point do Puppa or Yokoyama, alone or in combination, teach or suggest the above-mentioned features required by Claim 20.

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Applicants respectfully submit that Claims 21 and 26-30, which ultimately depend from Claim 20, are patentable over the art of record by virtue of their dependence. Further, Applicants submit that Claims 21 and 26-30 define patentable subject matter in their own right. Therefore, it is respectfully requested that the rejection of Claims 21 and 26-30 be reconsidered and withdrawn.

Claim 22 was rejected under 35 U.S.C. § 103(a), as being unpatentable over EP 1320819 to Puppa et al. (Puppa) and U.S. Patent No. 6,947,739 to Yokoyama (Yokoyama) as applied to Claim 20 and in view of PG PUB 2004/0099949 to Mohan et al. (Mohan).

Applicants respectfully submit that Claim 22, which depends from Claim 20, is patentable over the art of record by virtue of its dependence. However, it is admitted in the Office Action on page 19 that Puppa does not teach an Ethernet format or a first destination address comprising “a Virtual Local Area Network (VLAN) tag with the Ethernet-formatted first frame.” The examiner cites Mohan to overcome the deficiency. Mohan discloses an Ethernet frame format, Ethernet OAM operable within a domain or between domains, and VLAN tags to identify VLAN’s within a network.

Neither Puppa, Yokoyama, or Mohan, alone or in combination, teach or suggest all of the above-mentioned features. Specifically, Mohan also fails to teach or suggest a Remote Defect Indication, which sends a message back to a transmitting terminal that a failure has been

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indicated. Further, applicants submit that Claim 22 defines additional patentable subject matter in its own right. Therefore, it is respectfully requested that the rejection of Claim 22, under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

Claim 3 was rejected under 35 U.S.C. § 103(a), as being unpatentable over EP 1320819 to Puppa et al. (Puppa) and U.S. Patent No. 6,947,739 to Yokoyama (Yokoyama) as applied to Claim 1 and in view of PG PUB 2004/0099949 to Mohan et al. (Mohan). Claim 3 was cancelled rendering the rejection moot.

Claims 4, 5, and 7 were rejected under 35 U.S.C. § 103(a), as being unpatentable over EP 1320819 to Puppa et al. (Puppa) and U.S. Patent No. 6,947,739 to Yokoyama (Yokoyama) and PG PUB 2004/0099949 to Mohan et al. (Mohan) as applied to Claim 3, and further in view of PG PUB 2004/0202199 to Fischer et al. (Fischer). Claim 4 was cancelled rendering the rejection of Claim 4 moot.

Applicants respectfully submit that Claims 5 and 7, which depend from Claim 1, are patentable over the art of record by virtue of their dependence. Neither Puppa, Yokoyama, Mohan, or Fischer alone or in combination, teach or suggest all of the above-mentioned features. Further, Applicants submit that Claims 5 and 7 define patentable subject matter in their own right. Therefore, it is respectfully requested that the rejection of Claims 5 and 7 be reconsidered and withdrawn.

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Claim 8 was rejected under 35 U.S.C. § 103(a), as being unpatentable over EP 1320819 to Puppa et al. (Puppa) and U.S. Patent No. 6,947,739 to Yokoyama (Yokoyama) and PG PUB 2004/0202199 to Fischer et al. (Fischer) as applied to Claim 7 and in view of PG PUB 2004/0099949 to Mohan et al. (Mohan).

Applicants respectfully submit that Claim 8, which ultimately depends from Claim 1, is patentable over the art of record by virtue of its dependence. Neither Puppa, Yokoyama, Fischer, or Mohan, alone or in combination, teach or suggest all of the above-mentioned features. Further, Applicants submit that Claim 8 defines patentable subject matter in their own right. Therefore, it is respectfully requested that the rejection of Claim 8 be reconsidered and withdrawn.

Claim 9 was rejected under 35 U.S.C. § 103(a), as being unpatentable over EP 1320819 to Puppa et al. (Puppa), U.S. Patent No. 6,947,739 to Yokoyama (Yokoyama), PG PUB 2004/0099949 to Mohan et al. (Mohan), and PG PUB 2004/0202199 to Fischer et al. (Fischer).

Applicants respectfully submit that Claim 9, which ultimately depends from Claim 1, is patentable over the art of record by virtue of its dependence. Neither Puppa, Yokoyama, Mohan, or Fischer alone or in combination, teach or suggest all of the above-mentioned features. Further, Applicants submit that Claim 9 defines patentable subject matter in their own right.

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Therefore, it is respectfully requested that the rejection of Claim 9 be reconsidered and withdrawn.

Claims 7 and 23-25 were rejected under 35 U.S.C. § 103(a), as being unpatentable over EP 1320819 to Puppa et al. (Puppa) and U.S. Patent No. 6,947,739 to Yokoyama (Yokoyama) as applied to Claims 1 and 20, and in view of PG PUB 2004/0202199 to Fischer et al. (Fischer).

Applicants respectfully submit that Claim 7, which ultimately depends from Claim 1, is patentable over the art of record by virtue of its dependence. However, it is admitted in the Office Action on page 20 that Puppa does not teach that the “second destination address comprises an ATM Permanent Virtual Circuit (PVC) tag.” The examiner cites Fischer to overcome the deficiency. Fischer discloses a point-to-point connection for ATM data.

Neither Puppa, Yokoyama, or Fischer alone or in combination, teach or suggest all of the above-mentioned features. Applicants submit that Claim 7 defines patentable subject matter in their own right. Therefore, it is respectfully requested that the rejection of Claim 7 be reconsidered and withdrawn.

Applicants respectfully submit that Claims 23-25, which ultimately depend from Claim 20, are patentable over the art of record by virtue of their dependence. However, it is admitted in the Office Action on pages 20-22 that Puppa does not teach that the “second destination address

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comprises an ATM Permanent Virtual Circuit (PVC) tag.” The examiner cites Fischer to overcome the deficiency. Fischer discloses a point-to-point connection for ATM data.

Neither Puppa, Yokoyama, or Fischer alone or in combination, teach or suggest all of the above-mentioned features. Specifically, Fischer also fails to teach or suggest a Remote Defect Indication, which sends a message back to a transmitting terminal that a failure has been indicated. Further, Applicants submit that Claims 23-25 define patentable subject matter in their own right. Therefore, it is respectfully requested that the rejection of Claims 23-25 be reconsidered and withdrawn.

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### CONCLUSION

Claim 1 had been amended to incorporate the subject matter of allowable defendant Claim 6, including all of the limitations of intervening claims 3 and 4, and Claims 3, 4, and 6 have been cancelled. Similarly, allowable defendant Claim 10 has been rewritten in independent form to include all the limitations of the original Claim 1 and Claims 7, 8, and 9. Accordingly, Claims 1 and 10 are in condition for allowance. Moreover, it is assumed that all claims that depend on Claim 1, which includes Claims 2, 5, and 7-9, and all claims that depend on Claim 10, which includes Claims 11-19, are also in condition for allowance based on their dependence on allowable Claims 1 and 10.

Furthermore, the remarks regarding Claim 20 put it in condition for allowance. Accordingly, Claims 21-30 are also in condition for allowance based on their dependence on Claim 20.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this

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paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Having responded in full to the present Office Action, it is respectfully submitted that the application is in condition for allowance. Favorable action thereon is respectfully solicited.

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 08-2461. Such authorization includes authorization to charge fees for extensions of time, if any, under 37 C.F.R. § 1.17 and also should be treated as a constructive petition for an extension of time in this reply or any future reply pursuant to 37 C.F.R. § 1.136.

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Should the Examiner have any questions or comments concerning the above, the Examiner is respectfully invited to contact the undersigned attorney at the telephone number given below.

Respectfully submitted,



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